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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,994	01/12/2001	Wesley Everett Lamarche	1165.52US01	1055

23552 7590 06/24/2003  
MERCHANT & GOULD PC  
P.O. BOX 2903  
MINNEAPOLIS, MN 55402-0903

EXAMINER

HARRIS, CHANDA L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 06/24/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.



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~~90999~~ 7590 06/04/2003  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE 10TH FL.  
NEW YORK, NY 10151

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Mailed to wrong applicant

## Office Action Summary

Application No.

09/759,994

Applicant(s)

LAMARCHE ET AL.

Examiner

Chanda L. Harris

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## **DETAILED ACTION**

### ***Status of Claims***

In response to the remarks filed on 3/11/03, Claims 1-21 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 13-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Exactly how the Applicant arrives at the result wherein the same amount of scrolling is required to view the question portion on the first workstation display device and the other workstation display device is essential to make and use the invention and is not reflected in Claims 11, 14. Exactly how the Applicant arrives at the result of wherein the first test item appears the same size on the first display and the second display and wherein the test items appear the same size on the first display and the second display is essential to make and use the invention and is not reflected in Claims 13 and 16.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Martinez et al. (U.S. 5,211,564). The rejection from the previous office action is maintained and is incorporated herein by reference.**

1. [Claim 1]: Regarding Claim 1, Martinez discloses storing test content in a memory system, the test content (i.e. figures) including at least a question portion (i.e. question stem) and a response portion (i.e. response area). See Col.3: 39-46, Col.3: 63- Col.4: 4 and Col.4: 22-29. Martinez discloses capturing at least a portion of the test content in a test item image. See Col.3: 51-56. Martinez discloses overlaying a response control (i.e. tools) over the test item image, the test item image and response control together defining a test item. See Col.4: 39-47. Martinez discloses presenting the test item to respondent at the first workstation for electronically generating a response from the test item. See Col.3: 56-58. Martinez discloses test item images being in graphic form (i.e. bitmaps and/or coordinates for vector graphics). In Claim 1, Applicant does not disclose capturing a question portion and a response portion in a

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test item. Instead, Applicant discloses capturing *at least a portion* of the test content in a test item image.

2. [Claim 2]: Regarding Claim 2, Martinez discloses the step of receiving through the first workstation a response electronically generated by the respondent. See Col.3: 58-59.

3. [Claims 3, 5]: Regarding Claims 3 and 5, Martinez discloses the step of storing the test content further comprises positioning in at least one file the question portion, the response portion and an illustration portion and wherein the step of capturing comprises electronically capturing the test item image. See Col.3: 67-Col.4: 4.

4. [Claim 6]: Regarding Claim 6, Martinez discloses wherein the step includes storing test content that includes a text portion (i.e. textual statement) and an illustration. See Col.4: 22-28.

5. [Claim 7]: Regarding Claim 7, Martinez discloses overlaying a navigation control that is presented to the respondent for enabling for enabling the respondent the respondent to navigate forward or backward to other test items. See Col.4: 64-Col.5: 5.

6. [Claim 8]: Regarding Claim 8, Martinez discloses wherein the response control comprises at least one device (i.e. mouse) selecting one of a plurality of response options. See Col.3: 39-48.

7. [Claim 9]: Regarding Claim 9, Martinez discloses wherein the response control is selected from a group consisting of a radio box, a check box, a text box, an electronic drawing box, a drop and drag (i.e. move object) overlay, and a hot spot overlay. See Col.4: 39-41.

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8. [Claim 10]: Regarding Claim 10, Martinez discloses wherein a plurality of question portions and response portions are captured in a single test item. See Col.4: 22-25.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez in view of Loiacono (US 6,042,384). The rejection from the previous office action is maintained and is incorporated herein by reference.**

[Claim 4]: Regarding Claim 4, Martinez does not disclose expressly wherein the step of capturing comprises printing and then electronically scanning the test content.

However, Loiacono teaches electronically scanning test content in Col.1: 46-49.

Printing would inherently take place prior to scanning. Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to incorporate into the method and system of Martinez printing and then electronically scanning the text content, in light of the teaching of Loiacono, in order to provide a way to administer test content online.

**Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez.**

[Claim 12]: Regarding Claim 12, Martinez does not disclose expressly displaying the first item on a second display having a second resolution larger than the first resolution, wherein the same number of pixels is used to display the first test item on the first display and on the second display. However, at the time of the invention, it would have been an obvious to one of ordinary skill in the art that it would have been an obvious matter of design choice as to how many pixels to use to display a test item on a first display and on a second display wherein no stated wherein no stated problem is resolved or unexpected result obtained by using the same number of pixels to display a test item on a first and second display.

***Citation of Pertinent Prior Art***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Clark et al. (US 5,321,611)
  - image data
- Kucinski et al. (US 6,173,154)
  - imaging test answer sheets
- Bogdan (US 6,297,837)
  - displaying a window
- Bogdan (US 6,169,546)
  - scrolling system



***Response to Arguments***

Applicant's arguments filed 3/11/03 have been fully considered but they are not persuasive. See rejections above. This action is made NON-FINAL in light of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanda L. Harris whose telephone number is 703-308-8358. The examiner can normally be reached on M-F 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Ch.

ch.

June 2, 2003



S. THOMAS HUGHES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700